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EXAMINER				
THIER, MICHAEL				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATENT@PARK-LAW.COM

Office Action Summary

Application No.

10/824,909

Applicant(s)

PARK ET AL.

Examiner

MICHAEL T. THIER

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 250-291 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 250-291 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/ISD)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 1/22/2008

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 250-291 have been considered but are moot in view of the new ground(s) of rejection. The amendments to the independent claims filed 2/19/2008 are still felt to be read on by the provided references, and the examiner has adjusted the rejection to clearly point out how the newly added limitations are being interpreted and rejected. Please see the following rejection for a detailed explanation.

As for the argument with respect to the double patenting rejection of claims 250, 261, 271, and 282 over claims 1-26 of US patent no. 6,782,274, the examiner feels the double patenting rejection should be maintained and a more detailed explanation is provided below based on the filed amendments. Further, the applicant argues that Parks independent claims 1 and 13 focus on transmitting a radio resource message from a mobile station to a radio network, however, the examiner would like to note that claim 13 recites the message being transmitted from the radio network to the mobile station. Please see the following rejection.

Terminal Disclaimer

2. The terminal disclaimers filed on 9/19/2008 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of the US patent No. 6,741,868, US Patent No. 7,110,788, US Application No. 10/825281, and US Application No. 10/824908 has been reviewed and is accepted. The terminal

disclaimers have been recorded.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 250, 261, 271, and 282 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6,782,274. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the instant application are merely a broader version of the claims in patent no. 6,782,274. Please see the explanation below.

Instant application claim 250	US Patent No. 6,782,274 claims 2 and 15
<u>a) providing the terminal with a message comprising an information element identifying the operating type of the core network</u>	The method as recited in claim (1 or 13), wherein step a) includes: <u>receiving information related to an operating type of a core network;</u>

The comparison above clearly shows the double patenting rejection is proper, and that the claims of the instant application are clearly, and obviously encompassed by the claims from US patent no. 6,782,274.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 250-251,253-259,261-263,265,266,268-272,274-280,282 and 284-290 are rejected under 35 U.S.C. 102(e) as being anticipated by Korpela (US 5946634).

Regarding claim 250. Korpela teaches a method for interfacing between a terminal (10) and a radio network (20a-20c) connected to a core network (30a - 30c), wherein the terminal has either a synchronous operating type (Column 3, Line 66 - Column 4, Line 3; voice session and Figure 4; GSM) or an asynchronous operating type (Column 3, Line 66 - Column 4, Line 3; B ISDN and Figure 4) and the core network has an ANSI-41 operating type (Figures 8 & 9, Column 6, Lines 15-41 and Column 4, Lines 9-13; CDMA uses ANSI-41 standard), said method comprising the steps of:

a) providing the terminal with a message comprising an information element identifying the operating type of the core network (figure 8, which represents a signal transmitted by the radio access network to the mobile, contains item 102, which is the network type code, which indicates the network type, further see figure 9 and column 6, lines 15-41, i.e. the network type code, included in the transmitted signal, reads on the information element identifying the operating type of the core network).

Regarding claim 261. Korpela teaches an apparatus for interfacing between a terminal (10) and a radio network (20a-20c) connected to a core network (30a-30c), wherein the terminal has either a synchronous operating type (Column 3, Line 66 - Column 4, Line 3; voice session and Figure 4; GSM) or an asynchronous operating type (Column 3, Line 66 - Column 4, Line 3; B ISDN and Figure 4) and the core network has an ANSI-41 operating type (Figures 8 8.; 9, Column 6, Lines 15-41 and Column 4, Lines 9-13; CDMA uses ANSI-41 standard), said apparatus comprising:

- a first storage device for storing core network operating type information representing an operating type of a core network (stored as a code file; 1222 and Figure 10);

- a detection block for reading the core network operating type information during a time period of initialization of the radio network (figure 9 step 1204 and column 6, Lines 30-51); and

- messaging block for providing the terminal with a message through a predetermined channel, the message including a master information block comprising an information element identifying the operating type of the core network (figure 8, which represents a signal transmitted by the radio access network to the mobile, contains item 102, which is the network type code, which indicates the network type, further see figure 9 and column 6, lines 15-41, i.e. the network type code, included in the transmitted signal, reads on the information element identifying the operating type of the core network).

Regarding claim 271. Korpela teaches a method for interfacing between a terminal (10) and a radio network (20a - 20c) connected to a core network (30a-30c), wherein the terminal has either a synchronous operating type (Column 3, Line 66 - Column 4, Line 3; voice session and Figure 4; GSM) or an asynchronous operating type (Column 3, Line 66 - Column 4, Line 3; B ISDN and Figure 4) and the core network has an ANSI-41 and GSM-MAP operating type (Figures 7-9, Column 6, Lines 15-41 and Column 4, Lines 9-13; CDMA uses ANSI-41 Standard), said method comprising the steps of:

a) providing the terminal with a message comprising an information element identifying the operating type of the core network (figure 8, which represents a signal transmitted by the radio access network to the mobile, contains item 102, which is the network type code, which indicates the network type, further see figure 9 and column 6, lines 15-41, i.e. the network type code, included in the transmitted signal, reads on the information element identifying the operating type of the core network).

Regarding claim 282. Korpela teaches an apparatus for interfacing between a terminal (10) and a radio network (20a - 20c) connected to a core network (30a - 30c), wherein the terminal has a either a synchronous operating type (Column 3, Line 66 - Column 4, Line 3; voice session and Figure 4; GSM) or an asynchronous operating type (Column 3, Line 66 - Column 4, Line 3; B ISDN and Figure 4) and the core network has an ANSI-41 and GSM-MAP operating type (Figures 7-9, Column 6, Lines 15-41 and Column 4, Lines 9-13; CDMA uses ANSI-41 standard), said apparatus comprising:

a storage device for storing core network operating type information representing

the operating type of the core network (stored as a code file; 1222 and Figure 10);

a detection block for reading the core, network operating type information during a time period of initialization of the radio network (figure 9 step 1204 and column 6, Lines 30-51); and

messaging block for providing the terminal with the core network operating type information contained in a message through a predetermined channel (figure 8, which represents a signal transmitted by the radio access network to the mobile, contains item 102, which is the network type code, which indicates the network type, further see figure 9 and column 6, lines 15-41, i.e. the network type code, included in the transmitted signal, reads on the information element identifying the operating type of the core network).

Regarding claims 251 and 272. Korpela further teaches wherein the step a) includes the steps of: a1) storing a core network operating type information included in the message in a storage device (stored as a code file, step 1222 and Figure 10); and a2) reading the core network operating type information stored on the storage device during a time period of initialization of the radio network (registering on network and proceeding using new protocols, steps 1230, 1232 and Figure 12).

Regarding claims 253,265,274 and 284. Korpela further teaches wherein the storage device includes a memory for storing the operating type of the core network (Column 5, Lines 9- 13).

Regarding claims 254, 266, 275 and 285. Korpela further teaches wherein the memory is a read only memory (ROM) (Column 5, Lines 9-13; EEPROM).

Regarding claims 255,268,276 and 286. Korpela further teaches wherein the step a) includes the steps of: a1) inserting the core network operating type information into the message/master information block (Column 6, Lines 15-24 and Figure 8); and a2) transmitting the message to the terminal through a predetermined channel (Column 6, Lines 14-28).

Regarding claim 256, 269, 277 and 287. Korpela further teaches wherein the predetermined channel is a synchronous channel (Column 6, Lines 14-28).

Regarding claim 257,270, 278 and 288. Korpela further teaches the core network operating type information is periodically inserted into the message/master information block (Column 6, Lines 15-24 and Figure 8).

Regarding claims 258, 279 and 289. Korpela further teaches wherein the message includes a master information block (Figure 8).

Regarding claims 259, 280 and 290. Korpela further teaches wherein the message includes a system information message (Figure 9).
Regarding claim 262, Korpela further teaches further comprising a second storage device, contained in the terminal, for storing the recognized operating type of the core network (Figure 5, 13).

Regarding claim 263. Korpela further teaches wherein the detection block includes: receiver block for receiving the master information block having the core network operating type information (Figure 9; from 1202 to 1204); and extraction block for extracting the core network operating type information from the received master information block (Column 6, Lines 30-51).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 252, 264, 273 and 283 are rejected under 35 U.S.C. 103(a) as being unpatentable over Korpela (US 5946634).

Regarding claim 252,264, 273 and 283. The examiner would like to note that official notice was previously taken for the limitations of these claims. (i.e. "Korpela meets all limitations of claim 252, 264, 273 and 283 but does not specifically teach using storage devices including a dip-switch for switching between states. The use of storage devices including a dip-switch for switching between states is very well known in the art and as such examiner takes Official Notice that it would have been obvious to one of ordinary skill in the art to provide a storage or memory device including a dip-switch for switching between states to indicate the operating type. Therefore, it would have been obvious to modify the art of Korpela of using storage devices including a dip-switch for switching between states to indicate the operating type.") The applicant's subsequent response did not traverse the official notice and therefore the claims becomes known as applicants admitted prior art, and thus are rejected as admitted prior art. See MPEP 2144.03 where it states, "If applicant does not traverse the examiner's assertion of official notice or applicant's traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in

the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate."

9. Claims 260, 267, 281, and 291 rejected under 35 U.S.C. 103(a) as being unpatentable over Korpela (US 5946634) in view of 3GPP TS 25.331 V3.0.0 (1999-10).

Regarding claims 260, 267, 281 and 291. Korpela meets all limitations of claims 260, 267, 281 and 291, but does not teach wherein the message is represented by:

INFORMATION ELEMENT	PRESENCE	MULTI	IE TYPE AND REFERENCE	SEMANTICS DESCRIPTION
OTHER INFORMATION ELEMENTS				
MIB VALUE TAG	M			
REFERENCES TO OTHER SYSTEM INFORMATION BLOCKS		1..<MAX SYS INFO BLOCK COUNT>		
>SCHEDULING INFORMATION	M			
CN INFORMATION ELEMENTS				
CN TYPE	M		ANSI-41	
ANSI-41 INFORMATION ELEMENTS	C-ANSI			

CONDITION	EXPLANATION
GSM	THIS INFORMATION ELEMENT SHALL BE PRESENT IN CASE (CN TYPE == "GSM-MAP") OR (CN TYPE == "GSM-MAP AND ANSI-41")
ANSI	THIS INFORMATION ELEMENT SHALL BE PRESENT IN CASE (CN TYPE == "ANSI-41") OR (CN TYPE == "GSM-MAP AND ANSI-41")

3GPP TS 25.331 V3.0.0 teaches the use of broadcast of system information to broadcast system information elements that are of the same nature in a system information block (see page 24, paragraphs 8. i. 1.1-8.1.1.1.2) and the system

information messages contains elements as set forth in the table representing the message (see page 148-163).

Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to combine the teaching of Korpela with the teaching of 3GPP TS 25.331 V3.0.0 to use the above formatted message to identify core networks available for call connections as taught by the Specification in order to standardize effectively ensure connection parameters availability.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL T. THIER whose telephone number is (571) 272-2832. The examiner can normally be reached on Monday thru Friday 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Eisen can be reached on (571) 272-7687. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MICHAEL T THIER/
Examiner, Art Unit 2617
10/30/08

/Alexander Eisen/
Supervisory Patent Examiner, Art Unit 2617